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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,328

03/31/2004

Erik D. N. Monsen

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919 7590 08/20/2008

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EXAMINER

WU, RUTAO

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/814,328	Applicant(s) MONSEN ET AL.	
	Examiner ROB WU	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. In response filed May 02 2008, the applicant amended claims 1 and 5. Claim 4 have been cancelled and claims 20 and 21 have been added. Claims 1-3, 5-21 are pending in the current application.

Response to Arguments

2. Applicant's arguments filed May 08 2008 have been fully considered but they are not persuasive.

The applicant argues that Montgomery does not disclose or anticipate steps (e) and (g) of claim 1, specifically (e) retrieving the identification code from the data center and the identification code read by the post office and (g) printing at the postage meter a certificate indicating that the identification code has been read by the post office to provide proof of mailing the mail piece having the identification code. The Examiner respectfully disagrees.

As presented in the previous office action, Montgomery et al does not expressly disclose the step: (e) retrieving the identification code from the data center and the identification code read by the post office; Montgomery et al does disclose a tracking information database 456 for storing each tracking ID that has been issued to an end user computer 308 and the postage information associated with each tracking ID ... and periodically retrieving postage information from the tracking information database 456

for transmission to the master tracking computer system 310. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Montgomery et al to retrieve the identification code from the data center and the identification code read by the post office since the delivery status are updated after the mail pieces is read by the postal authority, and it would be necessary for the postal authority to retrieve the identification code in order to update the delivery status.

With regards to step (g), as presented in the previous office action, Montgomery et al does not expressly disclose printing at the postage meter a certificate indicating that the identification code has been read by the post office. However, Montgomery does disclose that the status of the mailpiece is update by the central computer, and the status can be checked on a webpage (Fig 27). Therefore, at the minimum the status webpage can be printed to indicate that the identification code has been read by the post office. It would have been obvious at the time of the invention for Montgomery et al to substitute printing the webpage at anywhere a printer is available with printing the webpage at the postage meter. Since printing a webpage and printing at a postage meter are well known in the arts, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 5-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub No. 2003/0101147 to Montgomery et al.

Referring to claim 1:

a method for providing proof of mailing one or more mail pieces by a mailer, the method comprises the steps of:

(a) placing an identification code on individual mail pieces with a postage meter at a location other than a post office, wherein the identification code identifies the recipient of the mail piece and uniquely identifies individual mail pieces; [0112]

(b) transmitting the identification code to a data center; [0108]-[0110], [0184]

(c) depositing one or more mail pieces with the post office at the post office or at a location other than the post office; [0184]

(d) attempting reading by the post office at a location other than the post office or at the post office the identification code that is on one or more mail pieces; [0184], (Fig 31)

Montgomery et al does disclose a tracking information database 456 for storing each tracking ID that has been issued to an end user computer 308 and the postage information associated with each tracking ID ... and periodically retrieving postage information from the tracking information database 456 for transmission to the master tracking computer system 310. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Montgomery et al to retrieve the identification code from the data center and the identification code read by

the post office since the delivery status are updated after the mail pieces is read by the postal authority, and it would be necessary for the postal authority to retrieve the identification code in order to update the delivery status.

and

(f) notifying the postage meter that individual identification codes have been received by the data center and individual mail pieces identification codes have been read or not read by the post office. [0184], (Fig 31)

Montgomery et al does not expressly disclose printing at the postage meter a certificate indicating that the identification code has been read by the post office. However, Montgomery does disclose that the status of the mailpiece is update by the central computer, and the status can be checked on a webpage (Fig 27). Therefore, at the minimum the status webpage can be printed to indicate that the identification code has been read by the post office. It would have been obvious at the time of the invention for Montgomery et al to substitute printing the webpage at anywhere a printer is available with printing the webpage at the postage meter. Since printing a webpage and printing at a postage meter are well known in the arts, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Referring to claim 2:

the method claimed in claim 1, wherein the postage meter is an electronic postage meter. [0104]

Referring to claim 3:

the method claimed in claim 1, wherein the postage meter is a computer postage meter with a secure storage device. [0104], [0127]

Referring to claims 5 and 6:

Montgomery et al disclose storing a date and time of when the mailpiece was read. Montgomery et al does not expressly disclose printing on the certificate the date and time the mail pieces was read. However, it is well known in the arts for the status of the mailpiece to be printed for evidence purposes, therefore it would have been obvious for Montgomery et al to also print the date and the time of when the mailpiece was read for evidence purposes.

Referring to claim 7:

the method claimed in claim 1, further including the step of:
printing at the postage meter a certificate indication that the identification code has not been read by the post office after a certain period of time has elapsed after the data center has received the identification code from the meter. [0186]

Referring to claim 8:

the method claimed in claim 1, wherein the identification code is a unique number. [0078]

Referring to claim 9:

the method claimed in claim 1, wherein the identification code comprises: the serial number of the postage meter, and the date and time that the identification code was affixed to the mail piece. (Table 2)

Referring to claim 10:

the method claimed in claim 1, further including the steps of:

(a) printing a postal indicia on the mail piece for the payment of postage and any related postal fees; (Fig 2) and

(b) charging the postage meter for printing the postal indicia. [0187]

Referring to claim 11:

the method claimed in claim 10, further including the step of:

refunding the postage meter account for part or all of the postage and fees that have been placed on mail pieces having identification codes that have not been read by the post office after a certain period of time has elapsed after the data center has received the identification code from the meter. [0187]-[0189]

Referring to claims 12-14:

Montgomery et al does not expressly disclose notifying the mailer via telephone, e-mail, or facsimile that individual identification codes have been received by the data center and individual mail piece's identification codes have been read or not read by the post office. However, Montgomery et al does disclose that the mailpiece status can be checked on a website (Fig 27). Telephony, e-mail and facsimile are well known notification methods in the arts. Therefore, it would have been obvious at the time of the invention for one ordinary skilled in the arts to substitute the website with telephone, e-mail or facsimile to notify the mailer of the mailpiece status.

Referring to claim 15:

the method claimed in the claim 1, further including the steps of:

identifying the mailer's reference number of the document contained in the mail piece. (Table 3)

Referring to claim 16:

the method claimed in claim 15, further including:

(a) printing at the postage meter a certificate indicating that the identification code has not been read by the post office after a certain period of time has elapsed after the data center has received the identification code from the meter; (Table 3)

and

Montgomery et al does not expressly disclose the step (b) printing the mailer's reference number on the certificate of induction. However, since the reference number is known, it would have been obvious to print the reference number on the certificate of induction.

Referring to claim 17:

Montgomery et al does not expressly disclose printing the mailer's name on the certificate of induction. However, it would have been obvious for Montgomery et al to print the mailer's name on the certificate of induction to facilitate the identification process.

Referring to claim 18:

Montgomery et al disclose that the mailpiece status can be tracked and checked. (Fig 27) Montgomery et al does not expressly disclose printing at the postage meter a certificate indicating that the identification code has been read by the post office and printing the mailer's reference number on the certificate of induction. However, it would

have been obvious at the time of the invention for Montgomery et al to print the status of the mailpiece along with the mailer's reference number. Montgomery et al would have been motivated to do so to provide the mailer with a record of the mailpiece status.

Referring to claim 19:

Montgomery et al does not expressly disclose printing the mailer's name on the certificate of induction. However, it is well known in the arts at the time of the invention for the mailer's name to be printed on the certificate of induction for identification and evidence purposes. Therefore it would have been obvious at the time of the invention for Montgomery et al to also print the mailer's name on the certificate of induction for identification and evidence purposes.

Referring to claim 20:

Montgomery et al disclose wherein the mailer selected a service level for the mail piece to be certified mail. [0080]

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al in view of U.S. Pat No. 5,174,398 to Ng.

Montgomery et al disclose a plurality of type of service levels that a user can select for a mail piece. [0080] Montgomery et al does not expressly disclose that registered mail is a service level that can be selected.

Ng discloses many mail service levels can be selected, such as registered mail.
(col 1: lines 15-18)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Montgomery et al to include registered mail as a service level that a user can select for a mail piece since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

6. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROB WU whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. W./
Examiner, Art Unit 3628

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628